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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,266	03/21/2001	Binnur Al-Kazily	M-9529 US'	3951

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EXAMINER	
CLARK, ISAAC R	

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/814,266	AL-KAZILY ET AL.	
	Examiner	Art Unit	
	Isaac R Clark	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 March 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 are presented for examination.

Priority

2. No claim for priority has been made in this application.

3. The effective filing date for the subject matter defined in the pending claims in this application is 03/21/2001.

Drawings

4. The Examiner contends that the drawings submitted on 03/21/2001 are acceptable for examination proceedings.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5, 11 and 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 5 and 15 contains the trademark/trade names "HP" and "E-Speak". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or

trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a specific type of online service and, accordingly, the identification/description is indefinite.

8. Claim 11 is a dependent claim based on claim 10. Claim 11 recites the limitation "the computer" in lines 8-9 on page 20. The antecedent for this limitation in claim 10 is ambiguous because there are two computers described in claim 10. For the purpose of examining the subject matter of claim 11, it is assumed that "the computer" refers to the computer executing the computer instructions and not to the "remote host computer" described in claim 10.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-4, 6, 7, 9-14, 16, 17, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Vange et al. (hereinafter Vange) US 20020007404.

11. As per claim 1, Vange teaches a method for caching an online service on a local point of presence 206 (Fig. 2A; Paragraph 044); front end of intermediate server may be

at POP), the online service being hosted on a remote host computer 210-212 (Fig. 2A), the method comprising:

receiving a request, at a local point of presence, to access an online service (Fig. A, Paragraph 0060);

determining if the requested online service is locally stored on the local point of presence (Paragraph 0064);

in response to determining that the requested online service is not locally stored, downloading the requested online service from a remote host computer hosting the requested online service (Paragraph 0064); and

storing the downloaded online service on the local point of presence (Paragraph 0064).

12. Claim 10 is an apparatus claim covering the same subject matter as claim 1. Claim 10 is rejected on the same basis as claim 1.

13. As per claim 2, Vange teaches the method of claim 1 further comprising determining if the requested online service is downloadable by the local point of presence (Paragraphs 0026 and 0068).

14. Claim 12 is an apparatus claim covering the same subject matter as claim 2. Claim 12 is rejected on the same basis as claim 2.

15. As per claim 3, Vange teaches the method of claim 1 further comprising executing the requested online service on the local point of presence (Paragraph 0033, database query executed on POP server).

16. Claim 13 is an apparatus claim covering the same subject matter as claim 3. Claim 13 is rejected on the same basis as claim 3.

17. As per claim 4, Vange teaches the method of claim 1 wherein the requested online service is locally stored in cache memory (Paragraph 0064).

18. Claim 14 is an apparatus claim covering the same subject matter as claim 4. Claim 14 is rejected on the same basis as claim 4.

19. As per claim 6, Vange teaches the method of claim 1 wherein downloading the requested online service comprises downloading the online service object code (Paragraph 0026; Claim 10, lines 1-3).

20. Claim 16 is an apparatus claim covering the same subject matter as claim 6. Claim 16 is rejected on the same basis as claim 6.

21. As per claim 7, Vange teaches the method of claim 1 wherein downloading the requested online service comprises downloading data associated with the requested online service (Paragraph 0025).

22. Claim 17 is an apparatus claim covering the same subject matter as claim 7. Claim 17 is rejected on the same basis as claim 7.

23. As per claim 9, Vange teaches the method of claim 1 further comprising receiving one or more caching properties for a locally stored online service (Paragraph 0065).

24. Claim 19 is an apparatus claim covering the same subject matter as claim 9. Claim 19 is rejected on the same basis as claim 9.

25. As per claim 11, Vange teaches the computer readable storage medium of claim 10 wherein the computer hosting the computer instructions is a component of the local point of presence (Paragraph 0034).

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

27. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vange in view of Wray (US 20010023482).

28. As per claim 5, Vange does not teach the method of claim 1 wherein the requested online service conforms to HP's e-speak specifications.

29. Wray teaches online E-Speak compliant services stored on a server (Paragraphs 0164). It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Vange and Rene Salle to produce a POP server caching e-speak services because they both deal with the location and delivery of online services upon a client request. Furthermore, the teaching of Wray to accommodate E-Speak compliant services would result in a caching system where the accessed services have specified handlers and security properties (Wray Paragraph 0161).

30. Claim 15 is an apparatus claim covering the same subject matter as claim 5. Claim 15 is rejected on the same basis as claim 5.

31. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vange in view of Edwards et al. (hereinafter Edwards) US 6,591,288.

32. As per claim 8, Vange teaches the method of claim 1 further comprising:

maintaining an age limit for the requested online service (Paragraph 0065); and

in response to determining that the age exceeds the age limit, removing the locally stored online service from the local point of presence (Paragraph 0065).

33. Vange teaches that a variety of algorithms may be used to determine when a requested online service should be removed from storage at the local point of presence (Paragraph 0064). However Vange does not explicitly teach determining an age of the requested online service locally stored on the local point of presence, the age being a time duration since the online service was last accessed.

34. Edwards teaches the method of claim 8 further comprising determining an age of the requested online service locally stored on the local point of presence, the age being a time duration since the online service was last accessed (Col. 7, lines 15-21). It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Vange and Edwards because they both deal with removing infrequently used online services from a cache. Furthermore, the teaching of Edwards of determining an age of the requested online service locally stored on the local point of presence, the age being a time duration since the online service was last accessed, would produce a cache system in which infrequently requested pages are removed from the cache making more room to accommodate frequently requested pages.

35. Claim 18 is an apparatus claim covering the same subject matter as claim 8. Claim 18 is rejected on the same basis as claim 8.

36. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vange in view of Burns et al. (hereinafter Burns) US 6,275,496.

37. As per claim 20, Vange teaches a service caching system for locally storing a requested online service, the online service being hosted on a remote host computer, the system comprising:

a means for receiving a request to access an online service (Paragraph 0060);

a means for determining if the requested online service is locally stored on the local point of presence (Paragraph 0064);

in response to determining that the requested online service is not locally stored, a means for downloading the requested online service from a remote host computer hosting the requested online service (Paragraph 0064); and

a means for storing the downloaded online service on the local point of presence (item 207, Fig. 2A; Paragraph 0064).

38. Vange does not teach a means for maintaining a record of a plurality of online services locally stored on a local point of presence.

39. Burns teaches the system of claim 20 wherein the system comprises a means for maintaining a record of a plurality of online services locally stored on a local point of presence (Col. 8, lines 41-46). It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Vange and Burns because they both deal with caching remote online services at the local service

provider. Furthermore, the teaching of Burns to maintaining a record of a plurality of online services locally stored on a local point of presence would provide a database of usage patterns that would allow the local service provider to tune the cache system to accommodate resources requested most frequently by subscribers (Burns Col. 8, lines 49-53).

Conclusion

40. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to show the state of the art with respect to "System and method for service caching on demand".

i. US 6,240,447 Banga et al.

ii. US 6,529,955 Sitaraman et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac R Clark whose telephone number is (703) 605-1237. The examiner can normally be reached on Monday-Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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